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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/235,242	01/22/1999	WOLFGANG FRIEDRICH	48746	4979

26474 7590 11/14/2002

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EXAMINER
STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
1626	28

DATE MAILED: 11/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on October 25, 2002

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~or thirty days~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 2-6 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 2-6 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

09/235,242

* U.S. GPO: 1998-404-496/40517

DETAILED ACTION

Claims 2-6 are pending in the application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on October 25, 2002 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green {U.S. Pat. 4,617,154}, Sullivan, III et al. {U.S. Pat. 4,231,956} and O'Lenick, Jr. et al. {U.S. Pat. 5,196,589}, in combination with each other.

Applicants claim a process of making a γ-alkoxyamine by reacting an α, β-unsaturated nitrile with an alcohol in the presence of a basic catalyst (e.g., a diazabicycloalkene catalyst) to form a β-alkoxynitrile followed by hydrogenation of the β-alkoxynitrile in the presence of a hydrogenation catalyst (e.g., Raney nickel) to obtain a γ-alkoxyamine.

Green teaches a process of making a β-alkoxynitrile and a β-alkylthionitrile by reacting an α, β-unsaturated nitrile with an alcohol in

the presence of a diazabicycloalkene catalyst (see columns 1 and 2). However, Green does not teach the total scope of Applicants' diazabicycloalkene catalysts or Applicants' claimed hydrogenation step.

Sullivan, III et al. teach additional diazabicycloalkene catalysts useful in the preparation of a β-alkylthionitrile (column 5, lines 13-25).

O'Lenick, Jr. et al. teach a process of making a β-alkoxynitrile by reacting an α, β-unsaturated nitrile with an alcohol in the presence of a basic catalyst (see column 2, lines 1-9 and column 4, lines 35-42). O'Lenick, Jr. et al. further teach that a β-alkoxynitrile (the products also taught by Green) can undergo a hydrogenation process, without separation or neutralization of the basic catalyst, in the presence of a suitable catalyst (e.g., Raney nickel) to form a γ-alkoxyamine (column 2, lines 1-9 and column 4, lines 48-53).

The claimed process is no more than a selective combination of prior art teachings done in a manner obvious to one of ordinary skill in the art since each step of the process appears to be relatively complete in

itself and there is no indication of an interaction between steps of such a type that would lead one of ordinary skill in the art to doubt that a substitution of alternative steps known to the art could be made. *In re Mostovych*, 144 USPQ 38 (1964).

One skilled in the art would have been motivated to utilize the process of Green, especially in view of the teachings of Sullivan, III et al. and O'Lenick, Jr. et al., to arrive at the instant claimed process with the expectation of obtaining a γ-alkoxyamine. Therefore, the claimed process would have been suggested to one skilled in the art.

Response to Arguments

Applicants' arguments filed October 25, 2002 have been fully considered. Applicants argue that the Board of Patent Appeals and Interferences (BPAI) considered Sullivan to be "cumulative" and unnecessary to the rejection. Applicants argue that the basis of the

BPAI's affirmance was that they agreed with the examiner's position that "consists essentially of" did not exclude the presence of the free radical inhibitor described in O'Lenick, Jr. et al. but now that the claims recite "consists of", the entire basis of the rejection and affirmance has been removed. Applicants also argue the percentage yields of the products produced in the prior art and the percentage yields of the products produced by the instant claimed process.

All of Applicants' arguments have been considered but have not been found persuasive. The Sullivan et al. reference was applied to show that a class of diazabicycloalkene catalysts (see the catalyst genus in column 5) are used in a process of making a β-alkylthionitrile whereas the Green reference only teaches a few of the diazabicycloalkene catalysts in a process of making a β-alkoxynitrile and a β-alkylthionitrile.

Nowhere in the decision by the BPAI on August 21, 2002 affirming the Examiner did the BPAI state that the Sullivan reference was unnecessary. Instant claim 6 has been amended where the language

"consisting essential of" has been replaced by the language "consists of" . However, the BPAI stated, "Even if we were to accept the appellants' argument regarding the preclusion of the beneficial free radical inhibitor in the claims on appeal, our conclusion would not be altered. As indicated *supra* , O'Lenick specifically teaches that its process can be carried out without any free radical inhibitors" (see page 8 of the decision). Therefore, the amendment to instant independent claim 6 does not overcome the rejection.

Applicants' comparison of percentage yields is not persuasive since a true side-by-side comparison of unexpected, superior and beneficial results of the instant invention over the prior art has not been performed.

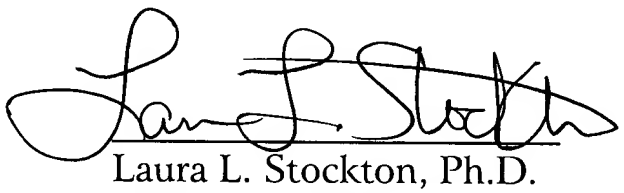
For all the reasons given above, the instant claimed invention is found to have been obvious to one skilled in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to

2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.



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Art Unit 1626, Group 1620
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November 12, 2002